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No. 04-

IN THE

Supreme Court of the United States

SAVIN ENGINEERS, P.C., JMOA ENGINEERING, P.C., and SAVIN CONSULTANTS, INC.,

Petitioners,

v.

SAVIN CORPORATION,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

The Petitioner (a professional engineering firm) and the Respondent (a copier company) use trademarks that incorporate the same word ("Savin"), but depict them in visibly different fashion and use them in different industries, with Petitioner using its mark in an industry which Respondent may not lawfully enter (licensed professional engineering). The District Court dismissed Respondent's dilution claim under the Federal Trademark Dilution Act, 15 U.S.C. § 1125(c) ("FTDA"), on the ground that use of the word "Savin" in connection with engineering services did not dilute Respondent's mark, for lack of proof of actual dilution. The Court of Appeals reversed, holding that whether marks are "identical" for FTDA purposes is "context and media specific" and that the existence of advertising by Respondent of its family name "Savin" as a mark comprised *prima facie* proof that its mark was "famous." The Court of Appeals held that, because Internet browser technology requires that words be typed in plain text, and because a word mark sounds the same when spoken irrespective of its visible depiction as a mark, the existence of such "context and media specific" "identical" aspects of marks can, under *Moseley v. V Secret Catalog*, 537 U.S. 418 (2003), substitute for proof of the statutory requirement of actual dilution. Both courts held that Respondent failed to prove trademark infringement. The questions presented for review are:

Whether, for purposes of trademark dilution under *Moseley*, the issue of identical-ness is "context and media specific" such that "identity" in any media context substitutes for proof of actual dilution under the FTDA?

Whether Internet browser's technology renders visibly dissimilar trademarks "identical" for purposes of trademark dilution under *Moseley*, and speech patterns render visibly dissimilar trademarks "identical," if the dissimilarity becomes less evident when typed in plain text as an Internet domain name or because word-based marks sound the same when spoken?

Whether, pursuant to *Moseley v. V Secret Catalog*, a claimant proves actual dilution under the FTDA merely by showing the commercial use of an "identical" junior mark?

What makes a mark "famous" for trademark dilution purposes; specifically, does proof of allegedly substantial advertising of the mark (here, "Savin" for copiers) at the time of alleged dilution suffice to establish *prima facie* the mark to have been "famous" at the time the alleged diluter first used it and thus making that word unusable in a mark in an unrelated industry, into which the complaining mark owner may not lawfully enter, even though the mark is not a household word, nor even fanciful, but is both a family name and a word used by many others in many contexts?

CORPORATE DISCLOSURE STATEMENT

Petitioners Savin Engineers, P.C., JMOA Engineering, P.C. and Savin Consultants, Inc. certify that petitioners have no parent corporation and that no publicly held corporation owns 10% or more of the stock of any of them.

TABLE OF CONTENTS

	Page
Questions Presented	i
Corporate Disclosure Statement	iii
Table of Contents	iv
Table of Cited Authorities	vi
Table of Appendices	ix
Opinions Below	1
Statement of Jurisdiction	1
Statutory Provision Involved	1
Statement of the Case	2
Reasons for Granting the Petition	7
I. Certiorari Should Be Granted To Resolve The Important Issue Of What Constitutes An Identical Mark When Visibly Dissimilar Marks Are Then Used In Internet Domain Names Or In Verbal Contexts Such As In A Radio Advertisement	7

Contents

Page

II. Certiorari Should Be Granted To Resolve The Conflicting Judicial Interpretations Of *Moseley* Regarding The Evidentiary Requirements For Establishing Actual Dilution Under The FTDA 10

III. Certiorari Should Be Granted Because Savin Copiers' Marks Are As A Matter Of Law Not Presently Famous Nor Did Savin Copiers Present Any Evidence That Its Marks Were Famous At The Time Savin Engineers First Used Its Mark In Commerce 14

Conclusion 17

TABLE OF CITED AUTHORITIES

Page

Cases:

Advantage-Rent-A-Car, Inc. v. Enterprise Rent-A-Car Co., 238 F.3d 378 (5th Cir. 2001) 16

AutoZone, Inc. v. Tandy Corp., 373 F.3d 786 (6th Cir. 2004) 9

Avery Dennison Corp. v. Sumpton, 189 F.3d 868 (9th Cir. 1999) 16

Fed. Express Corp. v. Fed. Espresso, Inc., 201 F.3d 168 (2d Cir. 2000) 9

Fossil Inc. v. Fossil Group, 49 U.S.P.Q.2d 1451 (T.T.A.B. 1998) 10

General Mills, Inc. v. Kellogg Co., 824 F.2d 622 (8th Cir. 1987) 9

Kellogg Co. v. Toucan Golf, Inc., 337 F.3d 616 (6th Cir. 2003) 13

Moseley v. V Secret Catalog, Inc., 537 U.S. 418 (2003) ..... *passim*

Nabisco, Inc. v. PF Brands, Inc., 191 F.3d 208 (2d Cir. 1999) 10, 11

Cited Authorities

	Page
Nitro Leisure Products, L.L.C. v. Acushnet Co., 341 F.3d 1356 (Fed Cir. 2003)	13
Playboy Enterprises, Inc. v. Netscape Communications Corp., 354 F.3d 1020 (9th Cir. 2004)	13
Savin Corp. v. The Savin Group, et al., 391 F.3d 439 (2d Cir. 2004)	8, 12
TCPIP Holding Co. v. Harr Communications, Inc., 244 F.3d 88 (2d Cir. 2001)	15
The Christopher D. Smithers Found., Inc. v. St. Luke's-Roosevelt Hospital Ctr., 2003 WL 115234 (S.D.N.Y. Jan. 13, 2003)	15
Toro Co. v. Torohead, Inc., 61 U.S.P.Q.2d 1164 (T.T.A.B. 2001)	15
Statutes:	
15 U.S.C. § 1125(c)(1) (2005)	2, 14, 16
15 U.S.C. § 1127 (2005)	14
28 U.S.C. § 1331 (2005)	6
28 U.S.C. § 1332 (2005)	6

Cited Authorities

Page

Other Authorities:

J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION, § 24:92 (4th ed. 2002) 15

Fed. Trademark Dilution Act: Hearing Before the Subcomm. on Courts, the Internet, and Intellectual Prop., House Comm. on the Judiciary, 107th Cong. 21 (statement of Ethan Horowitz, Partner, Darby & Darby, P.C.) (2002) 15

TABLE OF APPENDICES

Page

Appendix A — Opinion Of The United States Court Of Appeals For The Second Circuit Decided December 10, 2004 ..... 1a

Appendix B — Opinion And Order Of The United States District Court For The Southern District Of New York Dated October 24, 2003 ..... 41a

Appendix C — Order Of The United States Court Of Appeals For The Second Circuit Denying Petition For Rehearing Filed February 28, 2005 ..... 76a

Petitioners, Savin Engineers, P.C., JMOA Engineering, P.C. and Savin Consultants, Inc. (collectively referred to as "Savin Engineers") respectfully petition for a writ of certiorari to review the judgment of the United States Court of Appeals for the Second Circuit in this case.

OPINIONS BELOW

The District Court's opinion (per Scheindlin, D.J.) denying respondent's motion and granting petitioner's motion for summary judgment (Appendix B) is published at 68 U.S.P.Q.2d 1893. The Second Circuit's opinion (per Miner, J.J., joined by Meskill, JJ. and Katzmann, JJ.) reversing the judgment (Appendix A) is published at 391 F.3d 439. The Second Circuit's order denying rehearing *en banc* (Appendix C) is not published.

STATEMENT OF JURISDICTION

The Second Circuit entered its opinion and order on December 10, 2004, and denied rehearing *en banc* on February 28, 2005. This petition has jurisdiction under 28 U.S.C. § 1254(1).

STATUTORY PROVISION INVOLVED

The provision of the Federal Trademark Dilution Act, 15 U.S.C. § 1125(c), relevant to this Petition states that:

> The owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the

> distinctive quality of the mark, and to obtain such other relief as is provided in this subsection.

15 U.S.C. § 1125(c)(1) (2005).

STATEMENT OF THE CASE

Respondent Savin Corporation ("Savin Copiers") (a seller of photocopy machines and related office equipment) brought this action because petitioner Savin Engineers (a New York Professional Engineering corporation) refused to forfeit the good will that it has established over the preceding 16 years in the professional engineering field using its name "Savin Engineers." Savin Engineers has provided its clients with professional engineering and consulting services under that name since 1988.

About sixteen years after Savin Engineers began using the name "Savin" in commerce, Savin Copiers demanded that Savin Engineers wholly cease using the name "Savin" in connection with its business and that it irrevocably transfer to Savin Copiers all rights to the Internet domain names *savinengineers.com* and *thesavingroup.com.*

Savin Engineers, a New York State Professional Engineering corporation, is in the business of designing, building, testing and maintaining roads, bridges, buildings and wastewater facilities. Savin Engineers provides professional engineering and consulting services to large, sophisticated entities such as municipalities, education systems, school districts, transportation authorities, and environmental management companies.

Savin Engineers has never sold its customers office products such as photocopiers and/or other office equipment or offered such services as software design, network connectivity, or back

office "facilities management," nor does it intend to sell such products or offer such services to the consuming public.

Savin Engineers' founder and president "Dr. Nivas" – Dr. Rengachari Sri***nivas***aragahavan, a Ph. D. and New York State licensed professional engineer – named Savin Engineers. Since his days as an undergraduate, Dr. Nivas has been known by his nickname, "Nivas," which is contained within his full name, Sri***nivas***aragahavan. When Dr. Nivas, in approximately 1987, selected a name for his then new professional engineering business, he decided to use his nickname spelled backwards, "Savin."

Max Lowe, when he founded Savin Copiers in 1959, gave the company the family surname "Savin," after his brother-in-law, Robert Savin. Since then, Savin Copiers has marketed and sold business machines such as photocopiers, facsimile machines, printers and electronic data storage devices to the consuming public. Savin Copiers also offers support services for its office goods.

Savin Copiers holds federally-registered trademarks in connection with the following goods and services:

- *photocopy machines* and parts thereof (Reg. No. 1,174,900);
- developing liquid for office copiers and *photocopy machines* and copy paper for photocopy machines (Reg. No. 836,540);
- maintenance of repair services for *photocopiers* and word processors (Reg. No. 1,500,782);
- *facsimile machines* (Reg. No. 2,230,303).

Savin Copiers has a *de facto* policy of policing these trademarks only against those companies that offer competing products, such as copiers, copier parts, printers, facsimile machines, and facsimile parts that can be used in Savin Copiers' machines.

As is fully explained below, for a mark to be "famous" for anti-dilution purposes, it must be a true household word, of which there are few in the world. Moreover, it must possess that status continuously from a point in time prior to the first use by the allegedly junior user of the mark up through the time of the lawsuit. The reason for this demanding requirement is obvious, as anti-dilution protection operates to extend a mark into fields of endeavor in which its owner has no presence and grants the senior user property rights in gross in the mark.

Savin Copiers maintains that its marks are famous solely on the grounds that Savin Copiers spent $22 million in advertising during 2002. As a matter of law this showing is insufficient to prove fame. Moreover, nowhere does Savin Copiers allege or offer any evidence as to when its marks acquired this alleged fame, let alone prior to 1988 as required to maintain its dilution claim.

Savin Copiers admits that it does not compete with Savin Engineers. None of the product support technicians – essentially, computer installers and repairmen – that Savin Copiers employs are licensed by any U.S. jurisdiction as professional engineers. Savin Copiers has never offered, does not presently offer, and has no intention of ever offering professional engineering services to the consuming public in any jurisdiction. Savin Copiers does not have the requisite licensure to offer such services and is not incorporated as a professional services corporation.

Savin Copiers also admits that its marks and Savin Engineers' mark are dissimilar. Louise Stix, Savin Copiers' Manager of Corporate Communications and Creative Services, testified that the parties' stylized logos are different. Stix admits that: (1) the fonts of the parties' marks are different; (2) the Savin Engineers mark incorporates a four-cube graphic, which makes the Savin Engineers mark different from Savin Copiers' marks; and (3) both marks appear in different colors. Moreover, Stix admitted that "nobody is using *the identical characters . . . the identical way* with *the identical colors*."

A visual inspection of the parties' respective marks as shown below confirms Savin Copiers' concession that the marks are dissimilar and are certainly *not* identical.

Fig. 1 (Savin Engineers' mark)

Fig. 2 (Savin Copiers' mark)

savin

As for the three Savin Copiers' marks that were registered incorporating only the word "Savin" in a typed, block-letter format, such a registration does not create rights in the registered word when combined with other words or designs. Thus, Savin Engineers, whose mark incorporates different words and designs than the marks of Savin Copiers, is without question not identical.

Beyond this, several hundred other businesses nationwide use the name "Savin" in a wide variety of industries. A search for the name in an online directory resulted in a listing of more than two hundred businesses that use the name "Savin" nationwide in

myriad contexts. Such uses of the word "Savin" include, among others: Savin Brothers, Inc. (general contractors in Newington, CT), Savin Cleaners (dry cleaners in Chesapeake, VA), Savin Dental Associates (Glencoe, IL), Savin Diamonds (New York, NY), Savin Funeral Home (Philadelphia, PA), Savin Lumber Company (Buckhannon, WV), Savin Pharmacy (New York, NY), Savin Pools (El Cajon, CA), and Savin Products Company (janitorial supplies in Randolph, MA). Geographic places also bear the name "Savin", as does a medieval saint and cities named after him.

Throughout the entire sixteen years during which Savin Engineers and Savin Copiers have coexisted, Savin Copiers cannot point to so much as a single instance of actual consumer confusion regarding the source of a product and/or service as between Savin Copiers and Savin Engineers. In addition, Savin Copiers did not and cannot offer any proof of lost sales or loss of the economic value of its mark resulting from Savin Engineers' use of the word "Savin" in connection with offering its clients professional engineering and consulting services.

Despite the foregoing, Savin Copiers insists that it has the exclusive right to use any mark that includes the name "Savin" in connection with the sale of any good or service of any kind throughout the United States and, indeed, the world. Based upon the above facts, the United States District Court for the Southern District (Scheindlin, D.J.) dismissed Savin Copiers' Complaint in its entirety. Federal jurisdiction in the district court is based upon federal question jurisdiction pursuant to 28 U.S.C. § 1331 as well as diversity of citizenship of the parties pursuant to 28 U.S.C. § 1332. On appeal, the Second Circuit affirmed the District Court's dismissal of Savin Copiers' trademark infringement claim, vacated the District Court's dismissal of Savin Copiers' FTDA claim and remanded that action for a factual examination as to whether the above marks are identical.

REASONS FOR GRANTING THE PETITION

I.

CERTIORARI SHOULD BE GRANTED TO RESOLVE THE IMPORTANT ISSUE OF WHAT CONSTITUTES AN IDENTICAL MARK WHEN VISIBLY DISSIMILAR MARKS ARE THEN USED IN INTERNET DOMAIN NAMES OR IN VERBAL CONTEXTS SUCH AS IN A RADIO ADVERTISEMENT

Notwithstanding the fact that the marks at issue are completely dissimilar (as explained below), the Second Circuit reversed and remanded this case to the District Court for a determination of whether the marks at issue are "identical" under an FTDA dilution analysis in the "context and media specific" realms of Internet domain names and if used verbally. Certiorari should be granted to resolve this issue because, if such word marks are considered identical, that will throw trademark doctrine into chaos. All word based marks based on the same word must be typed in plain text in Internet domain names and will sound the same when spoken. Legions of trademarks that are in use, and untold thousands have been registered by the U.S. Patent and Trademark Office, are based on words with more than one user using the same root word. If that makes them "identical" for FTDA dilution purposes, then the statutory requirement for dilution has no meaning. Furthermore, this would allow a claimant to prove dilution by merely saying the word marks are "identical" when typed as part of an Internet domain name or spoken. Thus, the historically accepted test of visible dissimilarity would be rendered obsolete.

Because dissimilarities of words that comprise parts of marks cannot be differentiated by speaking the root word or

when the root word is part of a domain name because of the nature of Internet browser technology, the Second Circuit's ruling will prohibit entities with a long-used name from using their own names in commerce. Such an outcome would be a travesty.

The Second Circuit interpreted this Court's ruling in *Moseley* to mean that a plaintiff who owns an allegedly famous senior mark can prove dilution by merely showing an allegedly junior user's commercial use of a mark that is "identical" when applying any "context and media specific" analysis. *Savin Corp. v. The Savin Group, et al.*, 391 F.3d 439, 452-53 (2d Cir. 2004) (Appendix A). The Second Circuit explicitly held that the issue of whether the marks are identical can be "context- and/or media-specific." *Id.* Irrespective of visibly differentiating factors such as fonts, size, color, stylized graphics and the addition of other words, the Second Circuit noted that the plain type appearance of a domain name and how a word mark is pronounced are to be considered in deciding whether marks are identical. *Id.* at 453-54. Holding that the District Court did not conduct a sufficient analysis of whether the marks are identical, it reversed and remanded the action.

The Second Circuit specifically emphasized that marks may be identical under the FTDA where the junior and senior user's domain name share the same word such as the word "Savin" in www.savinengineers.com and www.savin.com. *See id.* Because all users must use plain text to input domain names in Internet browsers and words used in marks always sound the same when spoken, dissimilarities of the actual marks cannot be differentiated in those contexts. As a matter of law, a dilution claimant should not be permitted to ignore the graphic and textual dissimilarities of the marks and instead rely on the fact that the marks of the allegedly senior and junior user share the same word in order to prove the essential element of actual dilution.

Here, petitioner's allegedly junior mark incorporates different words and symbols and is graphically dissimilar to the allegedly senior marks of Savin Copies such that it is not identical as a matter of law. Even if one were to accept the Second Circuit's erroneous interpretation of *Moseley* that the "identical" nature of marks alone constitutes *prima facie* proof of dilution, Savin Copiers' FTDA claim must be dismissed because the marks, as a matter of law, are clearly not "identical."

When assessing the dissimilarity of marks, courts look to the *overall* impression created by a trademark, including the logo, typeface, the size of the logos, and the placement of the marks next to other identifying but dissimilar symbols. *See AutoZone, Inc. v. Tandy* Corp., 373 F.3d 786, 795 (6th Cir. 2004); *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627 (8th Cir. 1987). Courts have found marks to be dissimilar, even where parties use the same word to identify different goods and services, if that word appears in different typefaces and colors and is part of distinctively different logos. *See Fed. Express Corp. v. Fed. Espresso, Inc.*, 201 F.3d 168, 172, 174 (2d Cir. 2000).

Here, a visual inspection of the marks at issue reveals that they are dissimilar. As shown above, the marks' words, font, color, and overall appearance differ materially. Savin Engineers' mark incorporates graphics and other words. In contrast, Savin Copiers' mark only incorporates the word "SAVIN" with no other words. The mark appears in a single color, blue, and is presented in a different font than Savin Engineers' mark. *See* Statement of the Case, above.

In fact, Savin Copiers also admits that the marks are not identical and that the overall appearance of the marks is different, including a difference in fonts, colors, and graphics. Savin Copiers further concedes that "*nobody* is using *the identical characters . . . the identical way* with *the identical colors*." *See id.*

As for Savin Copiers' mark registrations incorporating only the word "Savin" in a typed, block-letter format, such a registration does not create rights in the registered word when combined with other words or designs. *See Fossil Inc. v. Fossil Group*, 49 U.S.P.Q.2d 1451 (T.T.A.B. 1998). Thus, Savin Engineers' mark, which incorporates different words and designs than Savin Copiers' marks, is not identical to the marks of Savin Copiers.

II.

CERTIORARI SHOULD BE GRANTED TO RESOLVE THE CONFLICTING JUDICIAL INTERPRETATIONS OF *MOSELEY* REGARDING THE EVIDENTIARY REQUIREMENTS FOR ESTABLISHING ACTUAL DILUTION UNDER THE FTDA

A split exists between the Second Circuit and the Sixth, Federal and Ninth Circuits regarding the evidentiary requirements for establishing dilution set forth in this Court's decision in *Mosely v. V Secret Catalogue, Inc.* This Court has held in *Moseley* that, in order to receive protection under the FTDA as applicable to this case, a plaintiff must prove *actual dilution* rather than a likelihood of dilution. 537 U.S. at 433.

In *Moseley*, this Court considered both the actual dilution and likelihood of dilution standards then existing for recovery under the FTDA. *Id.* at 421-22. As one of the Circuits that employed the likelihood of dilution approach to the FTDA, the Second Circuit ruled in *Nabisco, Inc. v. PF Brands, Inc.*, that likelihood of dilution must be determined through an assessment

of ten factors, *only one of which was similarity of the marks.*[1] 191 F.3d 208, 217-22 (2d Cir. 1999). Similarity of the marks was defined as "the *degree* of similarity of the junior mark to the senior." *Id.* at 218. In adopting an actual dilution standard, however, this Court found that even the ten-factor likelihood approach of *Nabisco* was wrong and would not justify recovery under the FTDA. *Moseley*, 537 U.S. at 432-33.

In *Moseley*, this Court responded to concerns that direct evidence of an actual dilution such as consumer surveys may be difficult to obtain by stating that:

> [i]t may well be, however, that direct evidence of dilution such as consumer surveys will not be necessary if actual dilution can reliably be proved through circumstantial evidence–the obvious case is one where the junior and senior marks are identical.

Id. at 434.

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1. The factors considered in a likelihood of dilution analysis were: (a) distinctiveness of the senior mark; (b) similarity of the marks; (c) proximity of the products and likelihood of bridging the gap; (d) interrelationship among the distinctiveness of the senior mark, the similarity of the junior mark, and the proximity of the products; (e) shared consumers and geographic limitations; (f) sophistication of consumers; (g) actual confusion; (h) adjectival or referential quality of the junior use; (i) harm to the junior user and delay by the senior user; and (j) effect of senior user's prior laxity in protecting the mark. *Nabisco*, 191 F.3d at 217-22. Borrowing on the law of trademark infringement, this Court stated that "'contextual factors' have long been used to establish infringement. We see no reason why they should not be used to prove dilution." *Id.* at 224. Thus, the likelihood of dilution analysis was very close to an infringement analysis.

In dismissing Savin Copiers' FTDA claim, the District Court correctly interpreted *Moseley* to mean that, where the marks are identical, a plaintiff may offer circumstantial as opposed to direct evidence of actual dilution, and rejected the proposition that if the marks are identical, that fact alone is sufficient circumstantial evidence of actual dilution.

The District Court, recognizing ambiguity of the above sentence, identified the following two possible interpretations. The first is when the junior and senior marks are identical, that fact in and of itself is sufficient circumstantial evidence to prove actual dilution. The second is that circumstantial evidence of actual dilution, as opposed to direct evidence, is sufficient when the marks are identical. The District Court correctly found that the latter interpretation is the correct interpretation because, in the sentence following its statement that actual dilution may be proven through circumstantial evidence, this Court stated:

> [w]hatever the difficulties of proof may be entailed, they are not an acceptable reason for dispensing with proof of an essential element of a statutory violation.

Mosely, 537 U.S. at 434.

On appeal, the Second Circuit vacated the District Court's dismissal of Savin Copiers' FTDA claim on the ground that the District Court did not conduct an adequate factual investigation as to whether the marks were identical. In reaching its decision, the Second Circuit rejected the District Court's interpretation of this Court's ruling in *Moseley* finding that "where a plaintiff who owns a *famous* senior mark can show the commercial use of an identical junior mark, such a showing constitutes circumstantial evidence of the actual dilution element of an FTDA claim." *Savin Corp.*, 391 F.3d at 452-53 (Appendix A).

In contrast to the Second Circuit's decision here, the Ninth, Federal and Sixth Circuits have held that a claimant must still offer evidence of actual dilution even if the marks in question are identical. In *Nitro Leisure Products, L.L.C. v. Acushnet Co.*, the Federal Circuit, interpreting *Moseley*, held that a manufacturer of golf balls was required to show actual evidence of dilution where the alleged junior user sold refurbished golf balls to the consuming public that bore the golf ball manufacturer's identical trademarks. 341 F.3d 1356, 1366 (Fed. Cir. 2003).

The Sixth Circuit in *Kellogg Co. v. Toucan Golf, Inc.*, found that a consumer survey was insufficient evidence to establish actual dilution where both the senior and junior marks used the name "Toucan." 337 F.3d 616 (6th Cir. 2003). Specifically, the Sixth Circuit found that the senior holder's consumer surveys failed to present evidence that any segment of the population recognized the word "Toucan" as the spokesperson for its Froot Loops breakfast cereal. *See id.* at 628-29. Thus, the Sixth Circuit's requirement that a claimant show evidence of actual dilution even where the marks are identical directly contradicts the Second Circuit's ruling below.

The Ninth Circuit decision in *Playboy Enters., Inc. v. Netscape Communications Corp.*, is also contrary to the Second Circuit's decision here. 354 F.3d 1020 (9th Cir. 2004). In *Playboy*, the Ninth Circuit found that aside from lack of capitalization, the fonts and the fact that the defendants used the plural form of "playmate", the term "playmate" was identical to the senior user's trademarks "playboy" and "playmate." *See id.* at 1023. Even though the court concluded that the marks at issue were identical, the court nevertheless held that the senior user's consumer survey evidence of actual dilution was insufficient under *Moseley*. *See id.* at 1033-34.

In order to resolve the foregoing split in the Federal Circuit, this petition for certiorari must be granted.

III.

CERTIORARI SHOULD BE GRANTED BECAUSE SAVIN COPIERS' MARKS ARE AS A MATTER OF LAW NOT PRESENTLY FAMOUS NOR DID SAVIN COPIERS PRESENT ANY EVIDENCE THAT ITS MARKS WERE FAMOUS AT THE TIME SAVIN ENGINEERS FIRST USED ITS MARK IN COMMERCE

The Second Circuit has so far departed from the acceptable and usual course of judicial proceedings as to call for this Court's supervisory power because it did not affirm the District Court's dismissal of Savin Copiers' FTDA claim where Savin Copiers failed to prove that its marks have reached the high degree of renown required by the FTDA and where Savin Copiers failed to prove the statutory requirement that the alleged junior user's "use begins *after* the mark has become famous."

Although the FTDA provides broad protection to a deserving mark owner because it prohibits another's use of the mark "regardless of the presence or absence of (1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake or deception," 15 U.S.C. § 1127, an owner must still establish both that its mark is "famous" and that it achieved that fame prior to the junior user's first use of its own mark. 15 U.S.C. § 1125(c)(1) (2005). Savin Copiers failed to establish either of these essential elements of its claim and for this additional reason, this Court should grant certiorari here to resolve the exceptionally important issue of what constitutes fame under the FTDA.

For a mark to be "famous," the consuming public as a whole must be able to associate the mark with its owner even when it encounters the mark apart from the owner's goods or services. *See, e.g., Toro Co. v. Torohead, Inc.*, 61 U.S.P.Q.2d 1164, 1177 (T.T.A.B. 2001). Moreover, Congress recognized that:

> [t]he theory of dilution stems from a recognition that there are some marks that are so famous and distinctive that they deserve special protection. For these famous marks, the traditional protection from confusion is not enough.

See Fed. Trademark Dilution Act: Hearing Before the Subcomm. on Courts, the Internet, and Intellectual Prop., House Comm. on the Judiciary, 107th Cong. 21 (statement of Ethan Horowitz, Partner, Darby & Darby, P.C.) (2002). The Second Circuit, in recognizing the intent of Congress, has ruled that only marks that have become "household words" are sufficiently famous under the FTDA. *TCPIP Holding Co. v. Harr Communications, Inc.*, 244 F.3d 88, 99 (2d Cir. 2001). Accordingly, "very few trademarks qualify as famous marks." *The Christopher D. Smithers Found., Inc. v. St. Luke's-Roosevelt Hosp. Ctr.*, 2003 WL 115234 at *5 (S.D.N.Y. Jan. 13, 2003) (citing 3 J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION, § 24:92 (4th ed. 2002)).

All that Savin Copiers offered to prove "famousness" is its allegation that Savin Copiers spent "over $20 million on advertising in 2002 and has achieved annual revenues of $675 million," and conclusory statements concerning the marks' alleged fame. That showing is grossly insufficient to raise a factual issue as to whether the word "Savin" is "famous," *i.e.*, akin to household words. *See TCPIP Holding Co.*, 244 F.3d at 99-100. The Second Circuit itself has found marks to fall short of

being "famous" despite sales and advertising figures greater than those alleged with respect to the "Savin" mark. *See id.* (insufficient evidence of fame where the senior user's affidavit asserted "'tens of millions of dollars'" spent on advertising, but did not assert "when expended, or how effectively"); *see also Advantage Rent-A-Car, Inc. v. Enterprise Rent-A-Car Co.*, 238 F.3d 378, 379, 381 (5th Cir. 2001) (mark not famous despite advertising expenditures of over $130 million); *Avery Dennison Corp. v. Sumpton*, 189 F.3d 868, 873, 878-79 (9th Cir. 1999) (mark used for over seventy years, with annual sales of $3 billion, not famous). Indeed, Savin Copiers' marks are not famous as a matter of law.

Even beyond this, and even assuming, *arguendo*, that Savin Copiers offered evidence showing that its marks are currently famous, Savin Copiers tendered no proof that its alleged fame existed prior to Savin Engineers' first use of the word "Savin" in 1988. *See* 15 U.S.C. § 1125(c)(1) (2005). Absent a showing that its mark was famous prior to Savin Engineers' use of its own mark in 1988, Savin Copiers' dilution claim must fail as a matter of law. *See id.* As Savin Copiers has not met its burden of proving that its mark is famous and was famous prior to Savin Engineers' use of its mark in 1988, the Second Circuit should have affirmed the District Court order dismissing Savin Copiers' FTDA claim.

Based on the foregoing, the Court must grant Savin Engineers' petition for certiorari.

CONCLUSION

For the foregoing reasons, this Court should grant certiorari to: (i) address the important issue of what constitutes an "identical" mark when visibly dissimilar word marks are used in Internet domain names or spoken verbally; (ii) resolve the conflict between the Second Circuit and the Sixth, Federal and Ninth Circuits regarding the evidentiary requirements of proving actual dilution under the FTDA as set forth by this Court in *Moseley*; and (iii) review the ruling of the Second Circuit, which held that a question of fact exists as to whether Savin Copiers' marks are famous and discarded the requirement of proof of preexisting "famousness" and also improperly reversed the District Court's correct dismissal of Savin Copiers' FTDA claim as a matter of law.

Respectfully submitted,

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